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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,584	07/15/2003	Shoji Morita	023484-0150	6886
22428	7590	02/24/2005	EXAMINER	
FOLEY AND LARDNER			KIM, YOON YOUNG	
SUITE 500			ART UNIT	PAPER NUMBER
3000 K STREET NW				1723
WASHINGTON, DC 20007				

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/618,584	MORITA, SHOJI	
	Examiner Yoon-Young Kim	Art Unit 1723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 July 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 15 July 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>0703</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Analysis

1. Claims 1 and 20 misspell the word "state". Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3-5, and 7 rejected under 35 U.S.C. 102(b) as being anticipated by Faria, U.S. Patent No. 5,066391.

Regarding Claim 1, Faria discloses an oil filter (Fig. 1, #10) comprising: a housing main body (engine block referred to in Col. 3, Lines 53-55) having an oil inlet passage (connection to #48) and an outlet passage (connection to #50); a cover (#20, 40, 90) detachably attached to the housing main body on a vertically lower side thereof and having a recessed portion (#80, 100) that opens toward a housing main body side; an inner tubular member (#72, 74, 78, 102) disposed in the recessed portion of the cover so as to be movable into and out of the recessed portion; a seal member (#60) interposed between the inner tubular member and the cover so as to provide a seal therebetween; a biasing unit (Fig. 2, #98) for urging the inner tubular member in the direction to protrude from the recessed portion of the cover; and a filter element (#76) disposed in an oil flowing space defined between the housing main body and the cover for filtrating oil introduced thereinto; wherein when the cover is in a state of being attached to the

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housing main body, the inner tubular member is pushed down into the recessed portion of the cover against a bias of the biasing unit (Col. 5, Lines 37-42).

Regarding Claim 3, Faria discloses that the filter element is detachably attached to the inner tubular member (Col. 4, Lines 41-42).

Regarding Claim 4, Faria discloses that the cover is threadedly engaged with the housing main body (Fig. 2, #50).

Regarding Claim 5, Faria discloses that the inner tubular member comprises a tubular wall (#78) and a partition wall (#74, 112) closing an end of the tubular wall, the inner tubular member partitioning the oil flowing space into upper (#82) and lower (#100) oil collecting chambers located above and below the inner tubular member, at least one of the tubular wall and the partition wall of the inner tubular member being provided with a communication hole (#110) for providing communication between the upper and lower oil collecting chambers.

Regarding Claim 7, Faria discloses that the communication hole is formed in the inner tubular member at the position thereof corresponding to the lowermost position of the lower oil collecting chamber when the cover is removed from the housing main body and turned upside down so as to allow an open end of the recessed portion of the cover to face vertically downward (Fig. 2).

4. Claims 8 rejected under 35 U.S.C. 102(b) as being anticipated by Nelson, U.S. Patent No. 2,540,134.

Regarding Claim 8, Nelson discloses an oil filter comprising: a housing main body (Fig. 3, #18) having an inlet passage (#15) and an outlet passage (#14); a cover (#16) detachably attached (Col. 2, Lines 50-55) to the housing main body and having a recessed portion that opens toward a housing main body side; a partition member (#4) disposed in the recessed

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portion of the cover so as to be movable into and out of the recessed portion and partitioning a space between the cover and the housing main body into a filter chamber (#19) on a housing main body side and an oil suction chamber (#3) on a bottom side of the cover; a seal member (#22) interposed between the partition member and the cover to provide a seal therebetween; a biasing unit (#5) for urging the partition member in the direction to increase the volume of the oil suction chamber; a filter element (#8) disposed in the filter chamber for filtrating oil introduced thereinto; and a communication passage (#11) for providing communication between the oil suction chamber and the oil filter chamber; wherein when the cover is attached to the housing main body, the partition member is pushed down into the recessed portion of the cover against the bias of the biasing unit (Col. 3, Lines 3-7).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 9-12, 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Faria.

Regarding Claim 9, Nelson discloses an oil suction chamber (Fig. 3, #3) but does not disclose a check valve. Faria teaches a check valve disposed in the communication passage (Fig. 2, #102). It would have been obvious to one of ordinary skill in the art to modify Nelson by adding the element of Faria in order to provide a passageway when the oil pressure exceeds a predetermined value (Col. 5, Lines 32-36).

Regarding Claim 10-12, Nelson does not disclose an oil draining device comprising a check valve. Nelson does not disclose a valve. Faria teaches an oil draining device for allowing to open to the outside arbitrarily (Fig. 2, #120, 122) and teaches a check valve (Fig. 2, #102). It would have been obvious to one of ordinary skill in the art to modify Nelson by adding the element of Faria in order to draw off the oil (Col. 5, Lines 52-55) and to provide a passageway when the oil pressure exceeds a predetermined value (Col. 5, Lines 32-36).

Regarding Claim 15, Nelson does not disclose a threaded attachment between the housing and the main body. Faria teaches that the cover is threadedly engaged with the housing main body (Fig. 2, #50). It would have been obvious to one of ordinary skill in the art to modify Nelson by adding the element of Faria because threaded engagement is a method of attachment that is common in the oil filter art (Col. 1, Lines 18-25).

7. Claims 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Janik et al., U.S. Patent No. 5,525,225.

Regarding Claim 16, Nelson discloses a communication passage (Fig. 3, #11) but does not disclose that it is positioned to immerse into the oil remaining in the cover and the housing main body upon removal of the cover. Janik discloses a communication passage (Fig. 1, #24) having an end that is positioned so as to immerse into oil remaining in the cover and the housing main body upon removal of the cover. It would have been obvious to modify Nelson by adding the element of Janik in order to allow communication between the filter and cover (Col. 3, Lines 25-33).

8. Claim 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Faria in view of Janik.

Regarding Claim 20, Faria discloses an oil filter (Fig. 1, #10) comprising: a housing main body (engine block referred to in Col. 3, Lines 53-55) having an oil inlet passage (connection to #48) and an outlet passage (connection to #50); a cover (#20, 40, 90) detachably attached to the housing main body on a vertically lower side thereof and having a recessed portion (#80, 100) that opens toward a housing main body side; an inner tubular member (#72, 74, 78, 102) disposed in the recessed portion of the cover so as to be movable into and out of the recessed portion; a seal member (#60) interposed between the inner tubular member and the cover so as to provide a seal therebetween; a biasing unit (Fig. 2, #98) for urging the inner tubular member in the direction to protrude from the recessed portion of the cover; and a filter element (#76) disposed in an oil flowing space defined between the housing main body and the cover for filtrating oil introduced thereinto; wherein when the cover is in a state of being attached to the housing main body, the inner tubular member is pushed down into the recessed portion of the cover against a bias of the biasing unit (Col. 5, Lines 37-42). Faria does not disclose an oil collecting portion. Janik teaches an oil collecting portion at an outer circumferential periphery of the cover (Fig. 2, #60). It would have been obvious to one of ordinary skill in the art to modify Faria by adding the element of Janik in order to lock the cover to the housing (Col. 4, Lines 52-55).

9. Claims 17-19 rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Janik as applied to Claim 16 above, and further in view of Mules, U.S. Patent No. 5,584,987.

Regarding Claim 17, Nelson in view of Janik discloses a communication passage (Nelson, #11) that comprises an annular chamber formed between an opening portion of the housing main body and the cover, a first connecting passage (#26) formed in the housing main

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body to provide communication between a lower portion of the housing main body and the annular passage, and a second connecting passage (#24) formed in the cover for providing communication between the annular passage and the oil suction chamber. Nelson in view of Janik does not disclose that the communication is with an outer circumferential surface of the cover. Mules teaches an annular chamber (Fig. 1, #4) formed between an opening portion of the housing main body (#5) and an outer circumferential surface of the cover (#1). It would have been obvious to one of ordinary skill in the art to modify Nelson in view of Janik by adding the element of Mules in order to provide fluid communication between the cylinder block and the filter chamber (Col. 2, Lines 23-27).

Regarding Claim 18, Nelson in view of Janik does not disclose a check valve. Mules teaches a check valve disposed in the connecting passage (#8). It would have been obvious to one of ordinary skill in the art modify Nelson in view of Janik by adding the element of Mules in order to protect the system against excessive inflow pressure (Col. 2, Lines 59-62).

Regarding Claim 19, Nelson in view of Janik does not disclose that the annular passage slants downward. Mules teaches that the first connecting passage connected at one of opposite ends to the annular passage extends therefrom so as to slant downwards toward the other of the opposite ends (Fig. 1, #4). It would have been obvious to one of ordinary skill in the art modify Nelson in view of Janik by adding the element of Mules in order to limit distortion of the filter element under fluid pressure acting radially inwards (Col. 1, Lines 56-59).

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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11. Claims 2, 6, 13, and 14 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claims 2, 6, and 13, Applicant claims a volume of the apparatus by referring to the volume of oil. Since the volume of oil is not defined, the claims do not clearly state any volume and fail to provide structural limitation to the invention.

Claim 14 recites the limitation "the inner tubular member" in Lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yoon-Young Kim whose telephone number is (571) 272-2240. The examiner can normally be reached on 8:30-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on (571) 272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YK
02/17/05

W. L. Walker
W. L. WALKER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700